APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/234,351	01/20/1999	MARVIN L. WILLIAMS	WILLIAM-2	6210

7590   08/27/2002

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EXAMINER
NGUYEN, MAIKHANH

ART UNIT	PAPER NUMBER
2176	

DATE MAILED: 08/27/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

-- The MAILING DATE of this communication appears on the cover sheet with the c rrespondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>07/18/2002</u> .

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-27</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-27</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

   If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____ .

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

   a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)   4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)   5) ☐ Notice of Informal Patent Application (PTO-152)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .   6) ☐ Other: .

DETAILED ACTION

1.   This action is responsive to communications: amendment B filed on 06/18/200 to the

application filed 01/20/1999.

2.   Claims 1-27 are currently pending in this application. Claims 1-2, 5, 10-11,14, 19-20 and

23 have been amended by Applicant. Claims 1, 10, and 19 are independent claims.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Birrell et al.

(U.S. 6,029,164 – filed 09/1996) in view of **Applicant's Admitted Prior Art** (APA).

        As to independent claim 1, Birrell teaches an electronic mail program (e-mail; col.4,

lines 21-31), a system (the mail service system; col.4, lines 6-15) for establishing relationships

between hypertext references (a displayed message contains any "hot-links"; col.11, lines 54-63)

contained in e-mail messages (email messages; col.4, lines 21-31) received by the e-mail

program, comprising:

   - a message parser (the message can be parsed; col.10, lines 36-48 / new messages

received by the mail service system are stored, parsed in the message files; col.11, lines 29-38)

that locates hypertext references in first and second e-mail messages received by the e-mail

program (the first line of a displayed message contains any "hot-links" which the user can click

to display the message … with the HTML formatting; col.11, lines 54-63) and associated each

of the hypertext references with a sender of the first and second e-mail messages; and

   - a message organizer (organizing e-mail messages so that they can readily be located and

retrieved; col.4, lines 16-31) that allows a user (users; col.4, lines 5-20) to choose to display the

first and second e-mail messages in an order that is based on the hypertext references.

   However, Birrell does not explicitly teach "associated each of the hypertext references

with a sender of the first and second e-mail messages."

   APA teaches associated each of the hypertext references with a sender of the first and

second e-mail messages (with the advent of the Internet and HTML, user could send hypertext

information to each other within their e-mail message …when the e-mail recipient selects the

hypertext URL address contained in a given e-mail message, the e-mail recipient's Internet

browser can automatically seek out and display the associated information; Specification, page 2,

lines 6-14).

   It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to combine the teachings of APA with Birrell because it would have

provided the enhanced capability for minimizing the data transferred over the network. When

receivers receive email message, they simply click on URL address associated with the messages

to view the electronic documents.

As to dependent claim 2, Birrell teaches causing the e-mail program to display a message field containing the hypertext references (col.12, lines 1-13) and a from field containing the sender associated with each of the hypertext references.

However, Birrell does not explicitly teach " a from field containing the sender associated with each of the hypertext references."

APA teaches a from field containing the sender associated with each of the hypertext references (with the advent of the Internet and HTML, user could send hypertext information to each other within their e-mail message …when the e-mail recipient selects the hypertext URL address contained in a given e-mail message, the e-mail recipient's Internet browser can automatically seek out and display the associated information; Specification, page 2, lines 6-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Birrell because it would have provided the enhanced capability for minimizing the data transferred over the network. When receivers receive email message, they simply click on URL address associated with the messages to view the electronic documents.

As to dependent claim 3, Birrell teaches the first e-mail message is selected from the group consisting of: a direct e-mail message, and a newsgroup posting (col.1, lines 33-38).

As to dependent claim 4, Birrel teaches the hypertext references have associated viewing statuses, the message organizer identically marking viewing statuses of identical ones of the hypertext references (col.10, lines 1-48).

As to dependent claim 5, Birrell teaches the message organizer (organizing e-mail messages so that they can readily be located and retrieved; col.4, lines 16-31) orders based on the hypertext references and the sender associated with each of the hypertext references.

However, Birrell does not explicitly teach orders based on the hypertext references and the sender associated with each of the hypertext references.

APA teaches orders based on the hypertext references and the sender associated with each of the hypertext references (with the advent of the Internet and HTML, user could send hypertext information to each other within their e-mail message …when the e-mail recipient selects the hypertext URL address contained in a given e-mail message, the e-mail recipient's Internet browser can automatically seek out and display the associated information; Specification, page 2, lines 6-14).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teachings of APA with Birrell because it would have provided the enhanced capability for minimizing the data transferred over the network. When receivers receive email message, they simply click on URL address associated with the messages to view the electronic documents.

As to dependent claim 6, Birrell teaches the hypertext references are uniform resource locators (col.12, lines 1-14).

As to dependent claim 7, Birrell teaches the message organizer allows the user to view referenced resources according to the order (col.10, lines 1-7).

As to dependent claim 8, Birrell teaches a browser and the message organizer is capable of employing the browser to view information associated with the hypertext references (col.12, lines 1-67).

As to dependent claim 9, Birrell teaches the browser is capable of paging between pages of information associated with the hypertext references of the message organizer and the browser identically marks viewing statuses of identical ones of the hypertext references (col.10, lines 1-8 / col.11, lines 54-63).

Independent claim 10 is for a method presenting the system of claim 1, and is similarly rejected under the same rationale.

Dependent claims 11-18 include the same limitations as in claims 2-9, and are similarly rejected under the same rationale.

Independent claim 19 is directed to a program for performing the system of claim 1, and is similarly rejected under the same rationale. However, the claim 19 further recites:

- a message receiver;

- a message transmitter coupled to the message receiver;

- a message composer coupled to the message transmitter;

- a message store coupled to the message composer.

Birrell teaches:

- a message receiver (the messages were received; col.11, lines 4-38 / the message has been received; col.12, lines 38-44)

- a message transmitter (send a message; col.14, lines 50-54) coupled to the message receiver;

- a message composer (compose begins a new message; col.14, lines 15-33) coupled to

the message transmitter; and

- a message store (new messages are stored; col.11, lines 29-38) coupled to the message

composer.

As to dependent claims 20-27 include the same limitations as in claims 2-9, and are

similarly rejected under the same rationale.

Response to Arguments

4.   Applicant's arguments filed on July 18, 2002 have been fully considered but they are not

persuasive.

The broad claim limitations used in the application continues to read on the references

presented in the previous office action.

Applicant argues that *Birrell fails to disclose, among other elements, a message parser*

that locates hypertext references in e-mail messages and associates each of the hypertext

references with the sender of the e-mail message. (Remark; page 5, lines 14-16)

In response, Birrell teaches a message parser (the message can be parsed; col.10, lines

36-48 / new messages received by the mail service system are stored, parsed in the message files;

col.11, lines 29-38). APA teaches hypertext references in e-mail messages and associates each of

the hypertext references with the sender of the e-mail message (with the advent of the Internet

and HTML, user could send hypertext information to each other within their e-mail message

…when the e-mail recipient selects the hypertext URL address contained in a given e-mail

message, the e-mail recipient's Internet browser can automatically seek out and display the

associated information; Specification, page 2, lines 6-14). The combination of Birrell and APA

meets the claimed limitations.

Applicant argues that *Birrell does not disclose associating hypertext references with the*

sender of the e-mail messages. (Remark, page 5, lines 17-18)

In response, Examiner contends that the teachings of APA "with the advent of the

Internet and HTML, user could send hypertext information to each other within their e-mail

message …when the e-mail recipient selects the hypertext URL address contained in a given e-

mail message, the e-mail recipient's Internet browser can automatically seek out and display the

associated information"; (Specification, page 2, lines 6-14), meet "associating hypertext

references with the sender of the e-mail messages" as claimed by the Applicant.

As to dependent claims 2-9, 11-18 and 20-27, the arguments are not persuasive for reason

as discussed above with regards to independent claims 1, 10 and 19.

Conclusion

5.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure.

Nguyen   U.S Patent No. 6,377,978   issued dated: Apr 23, 2002

6.   Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Maikhanh Nguyen whose telephone number is (703) 306-0092.

The examiner can normally be reached on Monday - Friday from 8:30 am -5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Heather R Herndon can be reached on (703) 308-5186. The fax phone numbers for

the organization where this application or proceeding is assigned are (703) 308-5403 for regular

communications and (703) 308-5403 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding

should be directed to the receptionist whose telephone number is (703) 305-9000.

Contact Information:

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or fax to:
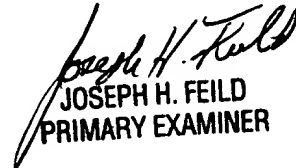AFTER-FINAL faxes must be signed and sent to (703) 746-7238.
OFFICIAL faxes must be signed and sent to (703) 746-7239.
NON OFFICIAL faxes should be sent to (703) 746-7240.

All OFFICIAL faxes will be handled and entered by the docketing personnel. The date
of entry will correspond to the actual FAX reception date unless that date is a Saturday,
Sunday, or a Federal Holiday within the District of Columbia, in which case the official
date of receipt will be the next business day. The application file will be promptly
forwarded to the Examiner unless the application file must be sent to another area of the
Office, e.g., Finance Division for fee charging, etc.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA., Sixth Floor (Receptionist). All hand-delivered responses will be handled
and entered by the docketing personnel. Please do not hand deliver responses directly to
the Examiner.

Maikhanh nguyen
August 23, 2002.

JOSEPH H. FEILD
PRIMARY EXAMINER